REMARKS

Applicant has reviewed the Office action mailed June 10, 2009. This response is filed with a petition for a one-month extension of time and because October 10, 2009, fell on a Saturday and October 12, 2009, was a holiday (Columbus Day) this response therefore is timely.

Claims 1-4, 6-12, 14-19, and 21-22 are pending. Claims 5, 13, and 20 have been cancelled. Claims 6, 14 and 21 have been amended. Claims 1, 9, and 16 are independent.

Applicant's further remarks appear below following portions of the Office action, which appear in bold, single-spaced, nine-point font.

"Objection to the Disclosure"

The disclosure is objected to because of the following informalities: With respect to claim(s) 16-22, the disclosure fails to disclose "a computer readable medium" having' instructions executed by a processor. Suggest amending the specification as necessary. Appropriate correction is required.

With respect to claim(s) 1, 8, 9 and 16, the claims the limitation ". . . receiving a request to transmit data over a port of a switch at a requested transmission rates;

selecting one of the first plurality of data transmission rates or one of the second data transmission rates at which to transmit data over the port, wherein the selected transmission rate is based on the requested transmission rate" in appropriate lines. There is insufficient antecedent basis for these limitations in the specification. Appropriate correction to the claims is required.

The Office states the "disclosure is objected to," but does not cite any statutory or regulatory basis for such an "objection." Because the Office has not rejected or objected to any claim for the reasons cited in the Office's "Objection to the Disclosure," applicant does not understand the Office's statements quoted above to impede the patentability of the claims in any way. If the Office intends to object to or reject any claims for reasons related to the statements above it must provide some statutory or regulatory basis for its objection or rejection, so that Applicant has an opportunity to respond. If the Office does so in a next Office action, such action cannot be final because it would be the first time claims were rejected for such reasons.

Applicant has no duty to speculate as to what the Office's intent with respect to the language quoted above. However, applicant surmises that the Office may have paraphrased MPEP form paragraph 7.34.05 found in MPEP § 706.03(d). Applicant points out that the MPEP states "This form paragraph [i.e., ¶ 7.34.05) should ONLY be used in aggravated situations where the lack of antecedent basis makes the scope of the claim indeterminate. It must be

preceded by form paragraph 7.34.01." (Capital letters in original, underlining added). Applicant notes that the Office has failed to quote the language of form paragraph 7.34.01, which further strengthens Applicant's conviction that the Office, in fact, has not rejected any claim under 35 U.S.C., Section 112.

This makes sense because the scope of claims 16-22 clearly is not indeterminate. Applicant notes that MPEP 2173.05(e) states:

> **A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN THE DISCLOSURE IS NOT NECESSARILY INDEFINITE**
>
> The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

Here applicant filed claims 16-22 as part of his original application, and it is well settled that claims are part of the disclosure of a patent application. Thus, it appears non-sensical for the Office to object to claims 16-22 as lacking antecedent basis, when they provide antecedent basis for themselves as part of the original disclosure.

Moreover, paragraph 0020 of the application describes "a switch 110 [that] includes a central processing unit (CPU) 205; working memory 210; persistent memory 220; . . .all communicatively coupled to each other via a bus 260. The CPU 205 may include an INTEL PENTIUM microprocessor, a Motorola POWERPC microprocessor, or any other processor capable to execute stored stored in the persistent memory 220." Given the "great deal of latitude [applicants are given] in how thy choose to define their invention," under MPEP 2173.05(e), claims 16-22 clearly are not indefinite in view of the Detailed Description in this application.

At least for these reasons, applicant respectfully requests notice of the Office's "Objection to the Disclosure."

Claim Objections

Claims 6, 14 and 21 objected to because of the following informalities: The subject claims recite "...the first incremental value is 64 Kbps, the first incremental value is 1 Mbps ... ." this does not make sense. Appropriate correction is required.

Applicant has amended claims 6, 14, and 21 to address the Office's concern.

Rejections Under 35 U.S.C. § 101

Claim(s) 1-4, 6, 7 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (l) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

The elements of Claim(s) 1 of "storing, receiving, selecting or transmitting ..." are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent and further

1) do not tie to another statutory class (such as a particular apparatus) by identifying the apparatus that accomplishes the method steps.

2) do not have a structure required by the claim, or positively recited in the body of the claim in association with a step significant to the inventive concept.

A claim reciting an adequate structural tie must positively recite the structure of another statutory category in association with a step significant to the inventive concept. The following are examples of structural recitations that do not constitute adequate structural ties per se: (1) Structure recited in a preamble alone, (2) structure in a phrase expressing intended use or purpose, and (3) structure in a step insignificant to the inventive concept, such as nominal pre or post solution activity.

Applicant disagrees.

Claim 1 recites (emphasis added):

1. (Previously Presented) A method, comprising:

storing a first plurality of data transmission rates in a register, wherein each of the first plurality of data transmission rates are spaced from each other by a first incremental value;

storing a second plurality of data transmission rates in a register, wherein each of the second plurality of data transmission rates are spaced from each other by a second incremental value greater than the first incremental value;

receiving a request to transmit data over a port of a switch at a requested transmission rate;

selecting one of the first plurality of data transmission rates or one of the second data transmission rates at which to transmit data over the port, wherein the selected transmission rate is based on the requested transmission rate; and

transmitting data through the port using the selected data transmission rate.

Thus, claim 1 is tied to a particular machine that includes specific structural elements. The claimed subject matter cannot be performed by a mentally, verbally, or without a machine because it is necessary to store data transmission rates "in a register," and to transmit data "through [a] port of a switch." Applicant has reviewed the Office's August 2009, "INTERIM EXAMINATION INSTRUCTIONS FOR EVALUATING SUBJECT MATTER ELIGIBILITY UNDER 35 U.S.C. §101." Attached here as Appendix A, and the Instructions on pages 13 and 15 indicate that the subject matter of claim IS eligible subject matter under section 101.

Applicant recognizes that the present Office action was mailed before the Office's August 2009 Examination Instructions, and that the Examiner therefore did not have the benefit of the Office's guidance on this area of the law, but Applicant respectfully requests that the Office now withdraw the rejections under section 101.

Rejections Under 35 U.S.C. § 103

Claims 1-4, 8-12 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiussi et al (USP 6,693,913 B1) in view of Marin et al.

Re claim(s) 1, 8, 9 and 16, Chiussi discloses a method and apparatus, comprising:

storing a first plurality of data transmission rates in a register (Figs. 1-3, registers 12, 18), wherein each of the first plurality of data transmission rates are spaced from each other by a first incremental value (basic rate r l is the first incremental value as a discrete data rate, see also claim 1 lines 20-24);

storing a second plurality of data transmission rates in a register (Figs 1 & 2 represent a second data transmission rate in registers 12 and 18), wherein each of the second plurality of data transmission rates are spaced from each other by a second incremental value (basic rate 1-2 is the second incremental value);

receiving a request to transmit data over a port of a switch at a requested (claim 1, basic data rate is matched per the request of new connection establishment) transmission rates selecting one of the first plurality of data transmission rates or one of the second data transmission rates at which to transmit data over the port, wherein the selected transmission rate is based on the requested transmission rate (claim 1 lines 35-40; 62-67); and

transmitting data through the port using the selected data transmission rate (col. 9 lines 1-9).

Chiussi fails to explicitly disclose whereby the second data rate is greater than the first data rate.

Marin discloses whereby the second data rate is greater than the first data rate (Fig. 5, col. 11lines 14-20; 30-45). The allocation of variable data rates amongst different data types (i.e. Audio, video, data, et) allows for optimum bandwidth efficiency with minimum data loss.

Thus it would have been obvious at the time the invention was made to incorporate the teachings of Marin within Chiussi so as to improve overall network efficiency.

Applicant disagrees.

Chiussi does not disclose a "storing a first plurality of data transmission rates in a register, wherein each of the first plurality of data transmission rates are spaced from each other

by a first incremental value" and "storing a second plurality of data transmission rates in a register, wherein each of the second plurality of data transmission rates are spaced from each other by a second incremental value greater than the first incremental value." Thus, claim 1 requires two sets of transmission rates – the first set of rates has spaced apart from each other by a first incremental value and the second set of rates is spaced apart by a second incremental value. The Office is referred to FIG. 4 and 5 of the application to see this visually. In contrast, Chiussi appears to disclose registers 12 and 18 that can store different rates. See e.g., Chiussi, col.3:47-49 ("plurality of registers for storing pointers as heads 12 and tails 18 for maintaining the number N of rate FIFO queues 28, with the sessions 14-16 in a given queue having the same rate from among the rates $r_1 \ldots r_N$.").

The Office is incorrect to equate basic rates r_1 and r_2 that Chiussi uses to transmit date with the first and second incremental rates recited in the claims. The claims state that the incremental rates are the values by which the transmission rates are spaces from each other, not that the incremental rates are the transmission rates. For example, in a plurality of transmission rates {100, 110, 120, 130, 140, 150} the incremental rate would be 10, but that value does not match the value of any of the transmission rates.

Marin also does not disclose a "storing a first plurality of data transmission rates in a register, wherein each of the first plurality of data transmission rates are spaced from each other by a first incremental value" and "storing a second plurality of data transmission rates in a register, wherein each of the second plurality of data transmission rates are spaced from each other by a second incremental value greater than the first incremental value." Instead, Marin discloses calculating a plurality of values that have a spacing that varies between each of the consecutive values. See, e.g., col. 9:34 – col. 10: 30.

The Office's error is further illustrated by the statement in the Office action that "Chiussi fails to explicitly disclose whereby the second data rate is greater than the first data rate. Marin discloses whereby the second data rate is greater than the first data rate," because the claims state that it is the "second incremental value [that is] greater than the first incremental value," not that the second transmission rates are greater than the first transmission rates. Even if Marin did disclose a second data rate that is greater than a first data rate, that would be irrelevant to the claim language that relates to the first and second incremental rates.

At least for these reasons, Applicant respectfully requests that the rejection of Claims 1, 9, and 16 are independent, and their respective dependent claims, be withdrawn.

Conclusion

Applicant believes that all the application is condition for examination on the merits and respectfully requests such examination. The Examiner may telephone Applicant's attorney (202-470-6453) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3521.

Respectfully submitted,

Brake Hughes Bellermann LLP

Date October 13, 2009

By: /Paul W. Churilla – Reg. No. 47,495/
Paul W. Churilla
Reg. No. 47,495